



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. 09/786,566

Applicant: Yeong Kuang Oon

Filed: March 7, 2001

TC/AU: 3626 (Confirmation No. 3733)

Examiner: GLASS, RUSSEL S.

Docket No.: 208778 (Client Reference No. 142245/DJB/WMM/eb)

Customer No.: 23460

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection dated April 20, 2007, in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the following sheets.

Respectfully submitted,

Phillip Pippenger, Reg. No. 46,055
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza
180 North Stetson Ave., Suite 4900
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: July 20, 2007

MAILING/TRANSMISSION CERTIFICATE UNDER 37 CFR 1.8 OR 1.10			
I hereby certify that this document and all accompanying documents are, on the date indicated below, being <input type="checkbox"/> deposited with the U.S. Postal Service using "Express Mail" service in an envelope addressed in the same manner indicated on this document with Express Mail Label Number <input checked="" type="checkbox"/> deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed in the same manner indicated on this document, or <input type="checkbox"/> facsimile transmitted to the U.S. Patent and Trademark Office at fax number: (571) 273-8300.			
Name (Print/Type)	Phillip Pippenger, Reg. No. 46,055		
Signature		Date	July 20, 2007

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

There are clear logical and technical errors in the Office Action. As a result, a prima facie showing of unpatentability has not been made. The primary errors that necessitate reversal of the rejections will be discussed briefly below.

Status of Claims

Claims 28-37 are currently pending and stand rejected. Claims 1-27 were previously cancelled. Of the pending claims, claims 28 and 33 are independent. The pending claims can be found at pages 2-4 of the Amendment filed on February 15, 2007.

Summary of Claimed Subject Matter

The claimed subject matter pertains generally to a technique for embedding a patient medical record in a novel medical scripting language wherein instructions in fact embody executable embedded commands, while at the same time expressing the relevant medical information in accordance with predetermined syntactical and semantic constructs. As part of this invention, a novel medical scripting language is defined utilizing an Extended Backus Naur Format.

Thus, for example, claims 28 and 33 recite, among other limitations, the following:

... each record represented in a **medical scripting language** having predetermined syntactical and semantic constructs, being **defined in Extended Backus Naur Format** ...

While the Examiner purports to find a medical scripting language defined in Extended Backus Naur format in the APA (applicants' admitted prior art), this allegation is simply and clearly erroneous as a matter of the English language. There is no need for judgment calls or nuanced interpretation--the specification simply and clearly *does not say* what the Examiner seems to think it does.

Grounds of Rejection to be Reviewed

Independent claims 28 and 33, as well as the related dependent claims 29-32 and 34-37, stand rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (WO

96/41275), Liff (US 5,594,638), alleged applicant admissions, Oon (WO 97/48059), and Friedman (US 6182029). Applicant will dedicate most of the discussion to the independent claims, since reversal of those rejections should moot the rejections of all dependent claims as well.

Reasons for Withdrawal of Rejections

The Office Action acknowledged that Johnson fails to teach medical records represented in a medical scripting language including script instructions that contain embedded commands but asserted that those missing claim elements were admitted to be known in applicant's specification at page 10, lines 22-25 and page 14, lines 16-21 of the specification. The Office Action stated the following:

On page 10, lines 22-25 of the specification, applicant admitted that the medical scripting language defined by Extended Backus Naur Format is well known as described in Programming in Modula-2¹

(See Action at page 3). This is careless misreading of the words of the specification; the cited portion of the specification states exactly the following:

The structure of medical scripting language is defined in Extended Backus Naur Format, this same EBNF format is used to express high level computer languages such as Modula (Programming in Modula-2 by Niklaus Wirth, spronger [sic] Verlag 1982) and Smalltalk (Smalltalk V, Digitalk Corporation 1992).

This statement says that *EBNF* is known. It does not say, as alleged by the Examiner, that *the recited medical scripting language that uses EBNF* is known. The recited medical scripting language is mathematically *defined in EBNF*, the same way that this document is defined in English. The fact that English is well-known does not mean that the words of this document were preordained. Similarly, the fact that the generic EBNF mathematical principles were known does not imply the existence of a medical scripting language including script instructions that contain embedded commands.

Thus, the §103 rejections of the claims are not supportable for at least this reason, and the claims should be allowable.²

¹ Although the Examiner denies interpreting the specification in this manner, he in fact repeats the error! (See Action dated April 20, 2007, "Response to Arguments," paragraph 1).

² Turning briefly to applicant's prior work (WO 97/48059), this reference does not define a medical scripting language as defined by the current claims. Rather, this document concerns an invention involving a non-numeric medical spreadsheet.

Also, it is once again noted that certain claims contain limitations written in 35 U.S.C. §112¶6 format.³ These §112¶6 claims were treated incorrectly in the Action. The relevant claim limitations should have been examined pursuant to MPEP §2181, rather than simply being treated as other claim formats. Although applicant's prior response noted this problem and requested that the Examiner adhere to MPEP §2181, the Final Action again ignored the problem and did not address the claims under 35 U.S.C. §112¶6 as required by law. Even for just this additional reason, if for no other, reversal is entirely appropriate and necessary in this case.

³ See, e.g., claims 28 and 32.